was not described in the specification in such a way as to enable one skilled in the art to make or use the invention. The rejection is based on claim 1 being amended in the preliminary amendment to remove the phrase "provided that A or B cannot represent phenyl", while the specification still contains the proviso at page 6, line 5. Applicant has amended the specification at page 6, line 5 to remove the proviso "provided that A or B does not represent phenyl", which is inconsistent with the claims of the application as originally filed.

The Examiner further states that enablement is not directed toward compounds where A or B can be phenyl, and that none of the preferred embodiments or species has A or B as a phenyl ring, therefore compounds with A or B as a phenyl ring have no support in the disclosure. Applicant respectfully points out that lack of literal support for the claims is not the proper standard for a 35 U.S.C.§112, first paragraph, rejection.

Mere lack of literal support in the specification for the invention as claimed is not enough to carry the PTO's burden in rejecting claims under 35U.S.C.§112, first paragraph. *In re Wertheim*, 191 USPQ 90 (CCPA 1976); *In re Voss*, 194 USPQ 267 (CCPA 1977). In rejecting a claim under 35 U.S.C.§112 for lack of adequate descriptive support, the Examiner must establish that the originally-filed disclosure would not have reasonably conveyed to those of ordinary skill in the art that the applicant has possession of the subject matter as claimed.

In *Ex Parte Parke*, 30 USPQ 2d 1234 at 1236 (PBAI 1994), the Board reversed an Examiner's rejection under 35 U.S.C.§112 based on lack of adequate descriptive support because there was no literal basis for the claim limitation in question. The Board stated:

> Adequate description under the first paragraph of 35 U.S.C. 112 does not require *literal* support for the claimed invention. *In re Herschler*, 591 F.2d 693, 200 USPQ 711 (CCPA 1979); *In re Edwards*, 568 F.2d 1349, 196 USPQ 465 (CCPA 1978); *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that the [applicant] has possession of the concept of what is claimed. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

It is respectfully asserted that the herein amended specification of the present application fully supports the pending claims. The specification reasonably conveys to

one skilled in the art that they had possession of the invention as claimed. One skilled in the art reading the claims would clearly understand which compounds are within the scope of the claims. It is respectfully asserted that the specification provides adequate support for all of the compounds claimed and that Applicants are entitled to the full scope of the invention as presently claimed.

Applicant respectfully requests reconsideration of and withdrawal of the rejections under 35 U.S.C.§112, first paragraph.

The Examiner has rejected claims numbered 43 and 51 under 35 U.S.C.§112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because (a) claim 43 contains the exemplary language "in particular", and (b) claim 51 is an improper dependent claim because it depends on cancelled claim 37.

Applicant has amended claim number 43 to remove the phrase "in particular the Peroxisome Proliferator-Activated Receptors (PPAR),". Applicant has amended claim number 51 to depend upon claim number 36, rather than the previously cancelled claim number 37, thereby correcting the improper dependency. Applicant respectfully requests reconsideration of and withdrawal of the rejection under 35 U.S.C.§112, second paragraph.

Applicant has added new dependent claim 55 to further define the invention.

The Examiner has objected to claim number 34 as being dependent upon a rejected base claim. Applicant respectfully asserts that the amendment to the specification and arguments provided herein obviate the Examiner's objection. Applicant respectfully requests the reconsideration and withdrawal of the objection to claim 34.

Applicant submits that for the foregoing reasons together with the amendments to the claims, the rejections under 35 U.S.C. 112, first and second paragraphs have been overcome and the case is now in condition for allowance. Applicant respectfully requests reconsideration and withdrawal of the rejections.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached pages are captioned "Version with Markings to Show Changes Made".

The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this amendment or application. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

Date: April 21, 2003

Rosemarie R. Wilk-Orescan
Registration Number 45, 220
Novo Nordisk Pharmaceuticals, Inc.
100 College Road West
Princeton, NJ 08540
(609) 987-5969

V rsion with Markings to Show Changes Made

In the specification:

The paragraph beginning on page 6, line 1 was replaced with the following paragraph:

-- Y represents oxygen, sulphur or NR^{10}, where R^{10} represents hydrogen, C_{1-12}alkyl, aryl, hydroxyC_{1-12}alkyl or aralkyl groups or when Y is NR^{10}, R^8 and R^{10} may form a 5 or 6 membered nitrogen containing ring, optionally substituted with one or more C_{1-6}alkyl; n is an integer ranging from 1 to 4 and m is an integer ranging from 0 to 1 [, provided that A or B does not represent phenyl]; --

In the claims:

Claims numbered 43 and 51 were amended as follows:

43. (Twice Amended) A method for the treatment of conditions mediated by nuclear receptors, [in particular the Peroxisome Proliferator-Activated Receptors (PPAR),] the method comprising administering to a subject in need thereof an effective amount of the compound according to claim 1 or a pharmaceutically acceptable salt thereof.

51. (Amended) The pharmaceutical composition of claim **36** [37], wherein the compound is in a unit dosage form in the amount of between 0.1 to about 50 mg.

New claim number 55 was added:

55. (New) A method for the treatment of conditions mediated by the Peroxisome Proliferator-Activated Receptors (PPAR), the method comprising administering to a

subject in need thereof an effective amount of the compound according to claim 1 or a pharmaceutically acceptable salt thereof.